

Serial No.: 09/878,047
Art Unit: 2151
Atty Docket: BA1.P26

REMARKS

This amendment is responsive to the Office action made final mailed January 24, 2005 for the above-captioned application.

- Claim 1 has been objected to based on informalities. Claim 1 is canceled.
- Objections have been made to the drawings. Formal drawings are enclosed.
- Claim 1-17 have been rejected under 35 USC 103(a)
- Claims 1, 9, 16 and 17 are canceled.
- Claims 4 and 11 have been rewritten in independent format
- Claims 2, 3, 4, 6, 8, 10, 11, 13, and 15 are amended.
- No claims are added.
- Claims 2-8 and 10-15 are pending.
- Claims 4 and 11 are in independent format.

The rejections to claims 2-8 and 10-15 are respectively traversed. Reconsideration of the claims and withdrawal of the rejections are requested.

The Cited Art and the Claims Distinguished

Claims 1-3 and 9-10 have been rejected under 35 USC 103(a) as being unpatentable over Ozaki et al. (U.S. Patent No. 5,933,478) in view of Amin (U.S. Patent No. 6,630,883) and further in view of Lloyd et al. (U.S. Patent No. 6,779,178). Claims 4-7 and 11-14 have been rejected under the same grounds with an additional reference cited: Yabe et al. (EP 1,259,036).

Independent claims 1 and 9 have been canceled. Claim 4 has been rewritten in independent format including all the limitations of base claim 1. Claim 11 has been rewritten in independent format including all the limitations of base claim 9. Claims 2, 3, 6 and 8 have been amended to depend from claim 4. Claims 10, 11, 13 and 15 have been amended to depend from claim 11.

Claim 4 distinguishes over the cited art based at least upon the following claim limitations:

wherein the step of responding comprises:

- contacting the forwarding server with the message identifier specified within the mail notice in one communication sent from the destination address along one transmission path;
- contacting the source address specified within the mail notice in another communication sent from the destination address along another transmission path; and
- determining which one of the source address and the forwarding server respond first to contact with the destination address.

Claim 11 includes similar limitations recited in means plus function format.

The examiner recognizes that neither Ozaki, Amin nor Lloyd disclose or suggest such limitations.

The examiner cites that the step of contacting is taught in Yabe et al. at column 2, lines 9-21. The examiner cites that the step of determining is taught by Yabe et al. at column 2, lines 22-27.

These findings as to Yabe et al. are respectfully traversed.

Yabe et al. disclose an e-mail distribution control method. An e-mail is transmitted from a terminal 50A to a mobile station 10A via the internet 40 and a mobile packet communication network 20, (Yabe et al. at Fig. 1 and col. 8, lines 31-34). A gateway server 30 receives the e-mail from the terminal 50A. The gateway server includes an e-mail delivery managing unit 33, which stores the e-mail in a mailbox 34, (Yabe et al. at Fig. 3 and col. 8, lines 36-40).

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The e-mail delivery managing unit 33 then executes an e-mail delivery process, (Yabe et al. at col. 8, lines 45-49). The delivery process includes sending an e-mail arrival notice to the mobile station to whom the e-mail is addressed, (Yabe et al. at col. 8, lines 54-56). The e-mail delivery managing unit 33 then monitors to see if an acknowledgement is received from the mobile packet communication network, (Yabe et al. at Fig. 6 and col. 9, lines 1-10). If a normal acknowledgement is received, then the e-mail is transmitted from the e-mail delivery managing unit 33 to the mobile station 10A (Yabe et al. at Fig. 6 and col. 10, lines 42-51). If a normal acknowledgement is not received then the timing information is updated at the server 30 to try again later.

It is respectfully submitted that in Yabe et al. the destination does not respond by contacting both a forwarding server and a source address. Yabe et al. discloses that an acknowledgement or other status from the mobile packet communication network is received at the server 30. **There is no suggestion that the response is also being sent from the destination to the source address.** Thus, Yabe et al. does not teach or suggest determining which of the source address and forwarding sever responds first to the destination's response.

The examiner asserts that at col. 2, lines 9-21 Yabe et al. disclose contacting both the forwarding server and the source address. This interpretation is respectfully traversed. **Such lines refer to the arrival notice sent from the server 30 to the mobile station 10A, and to the status returned by the destination. The status is returned to the server. There is no teaching or suggestion of the destination also responding to the source address.**

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The arrival notice informs the destination that there is an e-mail message for the destination. **The status is returned from the destination along only one path. The status is returned only to the server, not the source. Because only one pathway is described for the status response, there is no suggestion of determining which of the server and the source respond first to the destination's status response. The destination's response always goes to the server. Thus, the server always receives the destination's response first. There is no need to test to determine whether the source received the destination's response before the server.**

The examiner asserts that at col. 2, lines 22-37 Yabe et al. disclose determining which of the forwarding server and source address respond first to the destination. However, such lines refer (i) to the communication status sent from the mobile packet communication network to the server 30, and (ii) to the setting of a waiting time **at the server** when communication is not normal so that a retry can occur later. The destination only responds to the server. There is no determination of whether the server or source responds to the destination's acknowledgement first.

Accordingly, it is respectfully submitted that the cited art does not disclose or suggest the method of claim 4, nor the system of claim 11. Reconsideration of the claims and withdrawal of the rejections is requested.

Claims 2-3, and 5-8 depend ultimately from claim 4, and distinguish over the cited art based at least upon the same reasons as discussed above concerning claim 4.

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Claim 6 further distinguishes over the cited art based at least upon the following claim limitations:

- receiving contact at the source address from the destination address;
- responsive to receiving contact at the source address, determining whether transmission of the mail message from the source location to the forwarding server is incomplete;
- when transmission to the forwarding server is still incomplete, pausing transmission of the mail message from the source location to the forwarding server, and
- transmitting the mail message from the source location to the destination address using the binary formatting protocol.

The cited art does not disclose a mobile station attempting to contact both the server and the source address of the message. The cited art does not disclose determining which responds first, nor receiving the message from the one that responds first. The cited art does not disclose evaluating whether the transmission from the source to the server is still ongoing once the destination responds to the first transmission, nor of pausing the second transmission when the destination responds to the source.

The examiner asserts that Yabe et al discloses at col. 7, line 31 to col. 8, line 29 pausing transmission of the mail message from the source to the forwarding server and transmitting the message from source to the destination. This finding is respectfully traversed. Such passage discloses the configuration of the gateway server 30. There is no teaching or suggestion of

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pausing transmission of the mail message from the source to the server. Such passage indicates that the server's e-mail delivery managing unit 33 receives the mail message and stores it.

Further, it is Yabe's e-mail delivery managing unit 33 of server 30, not the source location, which sends the mail message to the destination.

Claim 7 further distinguishes over the cited art based upon the following claim limitations:

- when transmission of the mail message from the source location to the destination address fails, resuming transmission of the mail message from the source location to the forwarding server; and
- when transmission of the mail message from the source location to the destination address succeeds, aborting transmission of the mail message from the source location to the forwarding server.

Claims 10, and 12-15 depend ultimately from claim 11, and distinguish over the cited art based at least upon the same reasons as discussed above concerning claim 11. Claim 13 further distinguishes over the cited art for the same reasons as given above concerning claim 6. Claim 14 further distinguishes over the cited art for the same reasons as given above concerning claim 7.

Conclusion

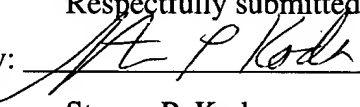
In view of the above remarks regarding the cited art, it is respectfully submitted that the claims contain key limitations that are not present in the cited art and not obvious from the cited art. These particular limitations are not disclosed in or suggested by cited references. These limitations are significant advances over the prior art and resulted in a novel method and apparatus for transmitting e-mail messages.

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In view of the above amendments and remarks, it is respectfully submitted that the claims are now in condition for allowance. The Examiner's action to that end is respectfully requested. Reconsideration of the claims and withdrawal of the rejections is respectfully requested.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the application, the Examiner is invited to call the undersigned attorney at the telephone number given below.

Dated: 4/14/2005

Respectfully submitted,
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